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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,649	04/19/2001	Gheorghe Cioca	2870/458	9217
7590 04/21/2004				
KAREN A LOWNEY, ESQ. ESTEE LAUDER COMPANIES 125 PINELAWN ROAD MELVILLE, NY 11747			EXAMINER WELLS, LAUREN Q	
			ART UNIT 1617	PAPER NUMBER

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,649

Applicant(s)

CIOCA ET AL.

Examiner

Lauren Q Wells

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 6-8, 13-18 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9-12, 19, 20 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/15/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-22 are pending. Claims 6-8, 13-18, and 21 are withdrawn from consideration, as they are directed to non-elected subject matter. The Amendment filed 1/15/04, amended claim 1.

Applicant's arguments toward the 35USC 112 rejection over the phrase "characterized by" in the previous Office Action, are persuasive, and therefore sufficient to overcome the rejection of the claims over this phrase. Characterized is definite and clear.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/15/04 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 9-12, 19-20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cioca et al. (6,139,855) in view of Beerse et al. (6,217,887).

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The instant invention is directed to structured water comprising a cluster structure, wherein at least two antimicrobial agents are within the cluster structure, and compositions and methods thereof.

Cioca et al. teach structured water in cosmetic compositions, wherein the compositions comprise a biologically active agent. The structured water is defined as water that contains stabilized clusters of ions. The composition contains a combination of I and S water, though it is disclosed that just I water or just S water can be utilized in composition. The I water is characterized by a conductivity of about 900-2500 and pH of about 1.9-2.5, and S water is characterized by a conductivity of about 400-1500, and a pH of about 10.5-12. It is disclosed that the composition can be used to enhance the activity of antibacterial agents. Exemplified is a method of topically applying the composition to the skin and a method of adding the clustered water to a cosmetic product, such as lipstick, foundation, blush, and others. See Col. 3, lines 43-Col. 4, line 26; Col. 1, line 19-Col. 2, line 66. The reference lacks a teaching of at least two antimicrobial agents within the cluster and silver ions.

Beerse et al. teach leave-on antimicrobial compositions which provide improved immediate germ reduction. Silver is taught as an active antimicrobial agent. See Col. 7, lines 54-67.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the silver of Beerse et al. as the biologically active agent of Cioca et al. because Cioca et al. teach antibacterials as biologically active agents, whose activity can be enhanced when combined with structured water; thus, one of skill in the art would be motivated

to combine the silver and structured water because of the expectation of achieving a topical cosmetic composition that is potent toward bacteria.

It is respectfully pointed out that a) silver must be within the cluster structure, as the electropositive charges of silver would interact with the electronegative charges within and without of the cluster structure; b) since a compound and its properties are inseparable (In re Papesch), and since the combination of references teach the cosmetic composition of the instant claims, the cosmetic composition must have the property of preserving the cosmetic.

A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches adding such structured water to a cosmetic composition as instantly claimed, which would inherently preserve a cosmetic as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

The Examiner respectfully points out the instant claims are product-by-process claims, i.e., the recitation "each resulting from feed water having uS/cm of about 470 to 520 and a pH of about 6.0 to 6.4". Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

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though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Claims 1, 3-5, 9, 11, 12, 19-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cioca et al. in view of Stroud et al. (6,231,837).

Cioca et al. teach structured water in cosmetic compositions, wherein the compositions comprise a biologically active agent. The structured water is defined as water that contains stabilized clusters of ions. The composition contains a combination of I and S water, though it is disclosed that just I water or just S water can be utilized in composition. The I water is characterized by a conductivity of about 900-2500 and pH of about 1.9-2.5, and S water is characterized by a conductivity of about 400-1500, and a pH of about 10.5-12. It is disclosed that the composition can be used to enhance the activity of antibacterial agents. Exemplified is a method of topically applying the composition to the skin and a method of adding the clustered water to a cosmetically active ingredient. See Col. 3, lines 43-Col. 4, line 26; Col. 1, line 19-Col. 2, line 66. The reference lacks a teaching of at least two antimicrobial agents within the cluster and potassium sorbate.

Stroud et al. teach cosmetic compositions. Potassium sorbate is disclosed as an antibacterial agent in cosmetic compositions. See Col. 18, lines 43-53.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the potassium sorbate of Stroud et al. as the biologically active agent of Cioca et al. because Cioca et al. teach antibacterials as biologically active agents, whose activity can be enhanced when combined with structured water; thus, one of skill in the art would be motivated

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to combine the potassium sorbate and structured water because of the expectation of achieving a topical cosmetic composition that is potent toward bacteria.

It is respectfully pointed out that a) potassium sorbate must be within the cluster structure, as the electrostatic charges of potassium sorbate would interact with the electrostatic charges within and without of the cluster structure; b) since a compound and its properties are inseparable (In re Papesch), and since the combination of references teach a cosmetic composition of the instant claims, the cosmetic composition must have the property of preserving the cosmetic.

A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches adding such structured water to a cosmetic composition as instantly claimed, which would inherently preserve a cosmetic as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

The Examiner respectfully points out the instant claims are product-by-process claims, i.e., the recitation "each resulting from feed water having uS/cm of about 470 to 520 and a pH of about 6.0 to 6.4". Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even

though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Response to Arguments

Applicant argues, "The structured water of the '855 reference is not made from the same feed water of the present invention, and consequently, does not contain within its cluster structures, the active in the '855 compositions". This argument is not persuasive. As pointed out in the above rejection, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113. '855 still teaches I and S water characterized by a conductivity and pH within the ranges recited in the instant claims.

Applicant argues, "The '855 reference fails to teach or suggest incorporating the active in the cluster structure of the I and S water. Rather, there is only mention of the active added to I and S water. Recall that I and S water is formed from treated feed water. The present invention is the surprising discovery that an active can be added to feed water and upon treatment is incorporated in the I and S water. . .". This argument is not persuasive. The Examiner respectfully points out that this argument is not commensurate in scope with the instant claims. The instant claims are directed toward a product and not toward a method of making a product. Additionally, as pointed out in the above rejection, a) silver must be within the cluster structure, as the electropositive charges of silver would interact with the electronegative charges within and

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without of the cluster structure; b) since a compound and its properties are inseparable (In re Papesch), and since the combination of references teach a cosmetic composition of the instant claims, the cosmetic composition must have the property of preserving the cosmetic. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches adding such structured water to a cosmetic composition as instantly claimed, which would inherently preserve a cosmetic as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed.

Applicant argues, "The structured water of the present invention, as amended, is distinguishable from the '855 structured water in two ways. First, as a result of making structured water from a combination of feed water and the antimicrobial agents, the antimicrobial agents are incorporated in the cluster structures of the structured water. And second, the feed water of the present invention is different than the '855 starting water". This argument is not persuasive. Again, Applicant is arguing that their product is distinguished by means of the method of making their product, when the claims are directed to the product. If Applicant truly has achieved a different product, and would like to claim the product in a product by process claim, the Examiner respectfully suggests that Applicant provide data that is commensurate in scope with the instant claims, showing how their method of production results in a product that is distinguished from that of the closest prior art.

Applicant argues, "Applicant argued as they do herein that 'two antimicrobial agents are incorporated within the cluster structure of structured water. . . This serves as evidence of the difference between the present invention and the mere addition of silver salts [sic] to structured water.' Applicants assert that this is not a mere statement but rather is supported by the present specification at page 12, lines 18-20". This argument is not persuasive. Page 12, lines 18-20, of the instant specification provide no data showing that adding the antimicrobial agents of Beerse or Stroud would not result in these agents being incorporated into the structured water.

Applicant argues, "Further, there is not teaching or suggestion in the '855 reference of the feed water having the pH of about 6.0 to 6.4 and a conductivity of about 470 to 520, and treating both the antimicrobial and the specific feed water of the present invention to integrate the antimicrobial in the cluster structure of the structured water". This argument is not persuasive. For the reasons given in the above paragraphs, this argument is not commensurate in scope with the instant claims.

Conclusion

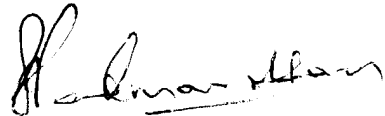
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



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